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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,267	06/23/2006	Ryoichi Okuyama	KPO-001	5649
32628 7590 08/03/2010 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848				
EXAMINER WIESE, NOAH S				
ART UNIT		PAPER NUMBER		
1793				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,267

Applicant(s)

OKUYAMA ET AL.

Examiner

NOAH WIESE

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-14, 16, 21-23, 27-28, 32-33, 39-40, 43, 47, 52, 55, and 58-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10, 12, 16, 21-23, 27-28, 32-33, 39-40, 43, 47, 52, and 55 is/are allowed.
- 6) ☒ Claim(s) 13, 14 and 58-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Application

1. The claims 1-10, 12-14, 16, 21-23, 27-28, 32-33, 39-40, 43, 47, 52, 55, and 58-77 are pending and presented for the examination.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 13-14, 58-66, and 68-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Cropley et al (US 6811905).

Regarding **claims 13-14**, Cropley et al teaches a methanol fuel cell that can be used in an alternative method to produce hydrogen. The fuel cell comprises a partition membrane with electrodes on opposing sides, wherein a methanol and water fuel mixture is introduced to one electrode and oxygen is introduced to the opposing electrode. Cropley also teaches a means for supplying an oxidizing agent and fuel containing an organic compound to opposite electrodes. Cropley teaches that there is a means for collecting (discharging) methanol, water, and carbon dioxide (see column 7, lines 25-35). This means is located at the anode (fuel electrode) side of the fuel cell and thus would be capable of collecting hydrogen if it was generated on this electrode. Therefore, it is a functionally equivalent means to that of the instant claim.

The hydrogen generating system taught by Cropley et al meets all of the structural limitations of instant claims 13-14, and therefore anticipates the claims. The designation of the amended claim that one of the configurations in which the system can operate is an open circuit configuration wherein no current is supplied to either

electrode is an intended use limitation. Whether current or not current is supplied to either electrode is a function of the process in which the claimed system is being used; it is not, therefore, a structural limitation that can be used to define a product claim. The system taught by Cropley could indeed have all of the needed connections for supplying current to the electrodes, but would still meet all of the patentably weighted limitations of the instant claims because the state of use of the instantly claimed system cannot be used in distinguishing the claims. For instance, the Cropley system (that meets all of the product limitations of the instant claims) would also meet the requirement that no current is supplied to either electrode when the system is off and not in use.

Similarly, the voltage between the electrodes in a generating system is a function of the use of said system and does not relate to the structure of the system. As such, the method of use limitations regarding the voltage between the electrodes do not hold patentable weight in the product claims, and as stated above, claims 13-14 are anticipated by Cropley.

Regarding **claims 58-61 and 68-71**, the limitations regarding varying of certain parameters during the use of the hydrogen generating system are process limitations. They therefore do not hold patentable weight in the product claims 58-61 and 68-71. As such, the claims do not further limit claims 13-14 and so they are anticipated by Cropley, which teaches a structurally equivalent system.

Regarding **claims 62 and 72**, the limitations regarding the operation temperature of the system are process limitations. They therefore do not hold patentable weight in

the product claims 62 and 72. As such, the claims do not further limit claims 13-14, and so they are anticipated by Cropley, which teaches a structurally equivalent system.

Regarding **claims 63 and 73**, Cropley teaches that the membrane is a proton conducting solid electrolyte membrane (see claim 1), and preferably, a perfluorosulfonic acid membrane (see column 10, lines 40-43).

Regarding **claims 64 and 74**, Cropley teaches that the anode (fuel electrode) comprises a platinum-ruthenium film (see column 4, lines 20-23). The film can be dispersed a support such as carbon (see column 8, lines 57-62).

Regarding **claims 65 and 75**, Cropley teaches that the cathode (oxidizing electrode) comprises a platinum film that can be supported on carbon powder (see column 4, lines 24-25 and column 8, lines 57-62).

Regarding **claims 66 and 76**, Cropley teaches that liquid fuel (a mixture of organic compound and water) is circulated for cooling of the cell, indicating a means for circulating fuel (see column 11, lines 41-42).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 67 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cropley et al (US 6811905) in view of Quang et al (US 4840783).

Regarding **claims 67 and 77**, the claim differs from Cropley et al because Cropley does not teach a carbon dioxide absorbing portion for removing carbon dioxide from the produced hydrogen gas. However, it would have been obvious to modify

Cropley in view of Quang et al in order to add such an absorbing portion to the system because Quang teaches a method of producing hydrogen from methanol involving an advantageous carbon dioxide absorbing portion (see claim 18). One of ordinary skill would have been motivated to include such an absorbing portion because doing so would result in a product gas produced by the Cropley system having a higher hydrogen purity. One would have expected reasonable success in the modification because Cropley teaches that hydrogen can be produced from the inventive system and Quang teaches a method for removing carbon dioxide from such produced hydrogen-containing gas. Therefore, claims 67 and 77 are obvious and not patentably distinct over the prior art of record.

Allowable Subject Matter

6. Claims 1-10, 12, 16, 21-23, 27-28, 32-33, 39-40, 43, 47, 52, and 55 are indicated as allowable. The following is an examiner's statement of reasons for allowance: The prior art of record, either alone or in combination, fails to anticipate or render obvious the instantly claimed method of producing hydrogen wherein fuel and oxidizing agent are introduced at two electrodes at opposites sides of a membrane, and wherein the hydrogen gas is generated at the fuel electrode (the anode). The prior art also fails to teach or suggest a hydrogen generating system having the configuration of instant claim 12 and its dependent claims, wherein neither electrode is connected to a means for withdrawing or providing electrical energy.

Response to Arguments

7. Applicant's arguments filed 05/25/2010 have been fully considered but are not persuasive.

Applicant repeats the earlier arguments regarding the different reactions that take place in the Cropley method and in applicant's claimed method, contending that because the instantly claimed system is used with different reactions it is distinct from the Cropley system. However, as also previously discussed, these differences in the reactions and the gasses generated at the respective electrodes are drawn to process limitations, and thus do nothing to show that the two systems (apparatuses) are in any way different. Indeed, applicant argues that it "can be said" that a means for collecting differs if that materials to be collected differ, but then proceeds to offer no reasons why this is true. Simply contending that a means for collecting one gas is different than a means for collecting another is not proof or evidence of distinction. Therefore, it remains clear that the collection means of Cropley is equivalent to that of the instant claims, is capable of collecting hydrogen, and reads on this limitation in the instant claims. The same holds true for the corresponding collection means on the cathode side.

Essentially, applicant contends that the fuel cell apparatus of Cropley is not equivalent to that of the instant claims because it is used to carry out different reactions. The argument, however, has been made that the components of Cropley could be used to carry out the reactions called for in the instant claims. Applicant has offered no arguments or evidence that this is not the case, or that the corresponding components are not equivalent. As such, the previously issued grounds of rejection are maintained,

and the Cropley apparatus is equivalent to that of instant claims even though the intended uses are different.

Conclusion

8. Claims 1-10, 12, 16, 21-23, 27-28, 32-33, 39-40, 43, 47, 52, and 55 are allowed and claims 13-14 and 58-77 are rejected.

9. Applicant's arguments are not persuasive and the previously issued grounds of rejection are maintained. Therefore, **THIS ACTION IS MADE FINAL.**

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOAH S. WIESE whose telephone number is (571)270-3596. The examiner can normally be reached on Monday-Friday, 7:30am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit 1793

Noah Wiese
30 July 2010
AU 1793